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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,821	01/24/2001	Maximilian Angel	51162	2188

26474 7590 10/09/2002

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,821

Applicant(s)

ANGEL ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-3 and 6-9 are pending. The Amendment filed 7/22/02, amended claims 1-2, 7-8, and amended the abstract.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 7/22/02 (Paper No. 8) to the rejection of claims 1-3 and 6-9 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's amendment filed 7/22/02 (Paper No. 8) is sufficient to overcome the 35USC 112 rejections and the objection to the specification in the previous Office Action.

The Terminal Disclaimer filed 7/22/02 is sufficient to overcome the Double Patenting rejections in the previous Office Action.

The Examiner again respectfully notes that Applicant has not filed a certified copy of the German application as required by 35 USC 119(b).

103 Rejection Maintained

The rejection of claims 1-3 and 6-9 under 35 U.S.C. 103(a) as being unpatentable over GB 922,459 is MAINTAINED for the reasons set forth in the Office Action mailed 2/21/02, Paper No. 7, and those found below.

Applicant argues, "The polyethylene glycols disclosed by the reference must have a molecular weight 'of 10000 up to several millions". This argument is not persuasive. First, the Examiner respectfully points out that independent claims 1 and 7 do not require polyethylene glycol. Second, the Examiner respectfully points out that the polyethylene glycols of GB 922,459 are not limited to a molecular weight of 10000 to several millions. The Examiner

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respectfully points out that the phrase 'of 10000 up to several millions', quoted by Applicant, refers to the preferred embodiment of the polyethylene glycols, but does not limit the polyethylene glycol to a molecular weight of 10000-several million. It is further respectfully pointed out that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 148; In re Lamberti, 545 F.2d 747; In re Fracalossi, 681 F.2d. In the instant case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a liquid polyethylene glycol as the solvent for the free-radical initiator system because the reference teaches that polyethylene glycols can be used as the solvent for the free-radical initiator system; thus, one of skill in the polymer art would be motivated to use polyethylene glycols of various molecular weights as solvents in free radical initiator systems for making copolymers of polyvinyl esters.

Applicant argues, "the object of applicants' invention was the development of a safe polymerization process in which the free radical initiator could be more easily metered than in the prior art". This argument is not persuasive. The Examiner respectfully points out that arguments or conclusory statements unsupported by factual evidence are insufficient to establish unexpected results. In re Linder, 173 USPQ 356 (CCPA 1972).

Applicant argues, "the examiner's statement that 'water-soluble polyethylene glycols are liquid polyethylene glycols' is erroneous". This argument is persuasive, as it is erroneous to equate a liquid state with solubility. However, for the reasons stated above, teaching the

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polyethylene glycol of GB '459 as a liquid polyethylene glycol, would be within the skill of one in the art.

Notes/Suggestions

(i) The Examiner respectfully points out that the instant independent claims do not require "liquid polyethylene glycol". The Examiner respectfully suggests that Applicant amend the claims to require "liquid polyethylene glycol" and define "liquid polyethylene glycol" as having a molecular weight between 88 and 1000, as recited on page 3, lines 9-13 of the specification. Though such an amendment would require a new search and further consideration, the amendment would overcome the GB 922,459 reference.

(ii) The Examiner respectfully points out that claims 7-9 are product-by-process claims and that determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The Examiner respectfully points out that the graft copolymers of polyvinyl esters and compositions thereof in the instant claims are well known in the art (see for example GB 922,459).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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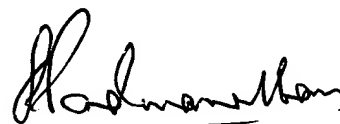
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
October 4, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

10/3/02

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DETAILED ACTION

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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October 4, 2002